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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,505	11/19/1999	MARIE-PASCALE AUDOUSSET	05725.0496-0	7297

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

35

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/443,505

Applicant(s)

AUDOUSSET, MARIE-PASCALE

Examiner

Margaret Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-3 and 5-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/31/03 has been entered.

Claim Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim '438 in view of Akram. This rejection is maintained for the reasons of record in the office action of 6/29/01 and subsequent office actions.

Lim, U.S. Patent No. 6,074,438, teaches and exemplifies compositions for dyeing hair which contain the oxidation base 2-chloro-4-aminophenol and a pyrazolone coupler, see Abstract and Table 1, Composition C. The exemplified composition is mixed with a hydrogen peroxide oxidant as is applied to hair as claimed, see col. 10, line 65-col. 11, line 2. Lim teaches that additional couplers may be added to the compositions in order to obtain certain color nuances and tints, including the claimed 2,6-bis(hydroxyethylamino)toluene, as well as direct dyes and additional p-aminophenol oxidation bases as claimed, see col. 5, lines 1-11 and 32-37, and col. 6, line 24. The additional p-amino phenol oxidative bases listed in column 5 lines 32-37 include several which are included in the claimed formula (I): 3-methyl-p-aminophenol, 2-hydroxymethyl-p-aminophenol, 2-methyl-p-aminophenol and 2-methoxymethyl-p-aminophenol. Lim teaches that the compositions may be packaged in kits as claimed, see col. 10, lines 46-54. Lim does not exemplify a composition, process or kit as claimed, particularly which contains or uses the claimed coupler, or which additionally comprises the above listed p-aminophenol oxidation bases.

Akrām is relied upon above as teaching that the claimed 2,6-bis(hydroxyethylamino) toluene has many improved properties when used as a coupler in hair dyeing compositions. See col 2 lines 24 et seq.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains an oxidation base and coupler as claimed, as well as the claimed additional couplers and direct dyes, wherein each component is present in the claimed amounts, is packaged in

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kits as claimed, and is applied to hair in dyeing processes as claimed, because such compositions, processes and kits fall within the scope of those as taught by Lim. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed 2,6-bis(hydroxyethylamino)toluene for use as the additional coupler in Lim's compositions because Lim teaches the claimed coupler as being suitable for use in the patentee's compositions, and because Akram teaches that the claimed 2,6-bis(hydroxyethylamino)toluene is preferred and results in various improved dyeing properties such as intense colors and resistance to various agents. Therefore, based upon Akram's teachings, those skilled in the art would have been motivated to select the claimed coupler from among those taught by Lim for use in Lim's compositions, absent a showing otherwise. It would have been obvious to add any or all of the claimed p-aminophenols listed in col 5 in the hair dyeing compositions as shown in order to provide a variety of shades of hair and additionally because it is notoriously well known in the hair dyeing art to combine several oxidation bases and couplers in oxidative hair coloring compositions, and the use of the additional bases and couplers falls within Lim's express teachings.

Response to Arguments

Applicant's arguments filed 2/19/2002, 1/31/2002 have been fully considered but they are not persuasive to overcome the above rejection. Applicant argues that there must be some suggestion in the references to modify the teachings of the references. Lim suggests the combination as claimed as he teaches that both of the components in

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the claimed compositions are suitable for use together in his disclosed compositions. Applicant states that Lim teaches that developers 1 and 2 may be combined with couplers 3,4 or 5. That is correct. But patentee also teaches that the claimed coupler and base may be used together. Applicant's composition are stated in comprising language; in no way do they exclude the additional components of Lim. It is notoriously well known that hair dyeing compositions may contain several dye bases, and Lim teach that the claimed dye base and coupler are suitable for use together in oxidation hair dyeing compositions. In other words, since Lim teaches that they are compatible, they have known utility in the same process under the same process conditions. Thus Lim alone is sufficient to provide a teaching that the two claimed components are useable together in oxidative hair dyeing compositions and processes. Applicant then states that the addition of Akram to the rejection adds an additional laundry list of couplers to the choice one has in the selection of a suitable combination. The office respectfully disagrees with this analysis. The addition of Akram narrows the choice since Akram gives the particular motivation to select 2,6-bis(hydroxyethylamino)toluene from the list of couplers suggested by Lim in column 6 lines 17-24.

Applicant further argues in the response of 2/19/2002 that while it may be feasible to use the two claimed components in Lim's composition, there is no teaching that it would be desirable. This office respectfully disagrees with that statement, Lim teaches that the claimed base and coupler may be used in his disclosed hair dyeing compositions. If the combinations were not desirable, why would he suggest that they be used? All disclosures of the prior art, including non-preferred embodiment, must be

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considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328 (CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one of ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123, "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.) *cert. denied*, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). Applicant is arguing working examples, not the entire disclosure. Applicant then argues that in **Winner** there was no motivation to substitute the device of the secondary reference in the mechanism of the primary reference. This case law is non-analogous to the issue at hand. The rejection is based on the fact that the claimed dye base and coupler are both suggested for use in the compositions of the primary reference. The rejection does not insert or substitute a compound from the secondary reference Akram into the composition of Lim. The rejection chooses from those suggested in the primary reference itself, and uses the

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secondary reference to give motivation from the secondary reference to choose the specific coupler as claimed.

Applicant further argues in the responses filed 1/31/03 and 2/27/03 that neither Akram nor Lim provide express motivation to make the specific selection as claimed by applicant. In response to this argument, Lim teaches that both may be used together in oxidative hair dyeing compositions and Akram gives the motivation to select the specific coupler. See above. Several of the claimed substituted p-aminophenols claimed in applicant's independent claims are specifically included in those named in Lim.

The following new grounds of rejection is applied.

Claims 1-3, 5-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Akram as applied to claims 1-3 and 5-18 above, and further in view of Claussen et al., US 4,997,451. The combination of Lim and Akram as applied above teaches that the claimed substituted p-aminophenol bases are compatible with the claimed coupler when used in oxidation dyeing compositions, and that the claimed coupler has certain advantageous properties which would motivate its selection for use in an oxidative hair dyeing composition. The following reference gives motivation to select one or more of applicant's claimed substituted p-aminophenol bases for use in a hair dyeing composition.

Claussen et al. teach the use of the claimed 4- amino-2-methoxymethylphenol (col 2 lines 5-33) as a preferred embodiment of his improved developers. He gives motivation for using said developer by stating at column 1 lines 38 et seq:

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"p-Aminophenol, alone or in a mixture with other developer substances, in combination with suitable coupler substances is especially preferred for producing natural and especially fashionable shades.

Considerations regarding physiological compatibility are currently being raised against the p-Aminophenol developer substances for the red part of the color spectrum, while more recently the developer substances recommended, e.g. pyrimidine derivatives, cannot be completely satisfactory in regard to dyeing.

Much research and development has been aimed at elimination of the disadvantage of poor physiological compatibility of the p-aminophenol developer substances used in the red region.

Thus oxidative hair dyeing compositions with a content of 4-amino-2-hydroxymethylphenol, which lead only to satisfactory hair color in the red range with a slight improvement relative to p-Aminophenol, are known and described in German Published Patent Applications DE-OS 3 441 148 and DE-OS 3 538 750.

SUMMARY OF THE INVENTION

It is an object of the present invention to provide an oxidative hair dyeing composition based on developer substances for the red range, which is comparable in color intensity and brightness with p-Aminophenol but has improved physiological compatibility."

It would have been obvious to the skilled artisan to select a substituted p-aminophenol for use in oxidative hair dyeing compositions instead of p-aminophenol because p-aminophenol has poor physiological compatibility, and since it has outstanding dyeing properties, a closely related substitute for it is actively sought by hair dyeing chemists. Accordingly, in the above passage, Claussen et al. give motivation to choose 4-amino-2-methoxymethylphenol as well as stating that the claimed 4-amino-2-hydroxymethylphenol is also an improvement over p-aminophenol.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and

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alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

A handwritten signature in cursive script, reading "Margaret Einsmann".

MARGARET EINSMANN

PRIMARY EXAMINER 1751